

### REMARKS

Reconsideration of this reissue application is respectfully requested.

Claims 2-4, 8, 11, 12, and 14-16 are pending in this reissue application.

Claims 2-4, 8, 11, 12, and 14-16 have been rejected as being based upon a defective reissue declaration under 35 U.S.C. §251 and for lack of error. The Examiner contends that the declaration fails to indicate the inventor's residence and mailing address. Submitted herewith is a substitute reissue declaration, which recites the inventor's residence and mailing address.

The Examiner also contends the applicant's assertion that "claims 14 and 16 patented as a result of a reexamination proceeding are broader than the original claims" violates 35 U.S.C. §305 and 37 C.F.R. §1.552(b), which prohibits enlarging the scope of a claim of a patent being reexamined.

U.S. Patent No. 5,565,109 ("the '109 patent") as modified by the Reexamination Certificate issued November 23, 1999 claims more than the applicant had a right to claim under 35 U.S.C. §305 during the reexamination proceeding (Substitute Reissue Declaration of Philip Sweeny, ¶ 5). Claims 1 and 13 of the '109 Patent as originally issued "required that the N-hydrogen compound be added directly to the circulating water system before or after addition of the slimicide or with the slimicide in a mixture consisting essentially of the slimicide and the N-hydrogen compound" (Substitute Reissue Declaration, ¶ 6). Claims 14 and 16, which were

added by the Reexamination Certificate, do not contain the aforementioned limitation (Substitute Reissue Declaration, ¶ 7). Thus, claims 14 and 16 of the '109 patent, as modified by the Reexamination Certificate, are broader than the claims of the original '109 patent. Since 35 U.S.C. §305 prohibits enlarging the scope of a claim of a patent during a reexamination proceeding, claims 14 and 16 are partly inoperative.

As the Examiner notes in the Office Action, 35 U.S.C. §305 prohibits enlarging the scope of a claim of a patent during a reexamination proceeding. In *Quantum Corp. v. Rodime PLC*, 36 USPQ2d 1162, 1168 (Fed. Cir. 1995) (a copy of which is enclosed), the court found claims that were improperly broadened during reexamination in violation of 35 U.S.C. §305 to be invalid as a matter of law. Thus, while 35 U.S.C. §305 prohibits broadening a claim during reexamination, the Patent Office may in error issue a reexamination certificate in which the modified claims are broader than the original patent claims.

35 U.S.C. §251 recites that "[w]hensoever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of the patentee claiming more ... than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention disclosed in the original patent ..."

See also M.P.E.P. §1402. "[T]he reissue statute, 35 U.S.C. §251, is remedial in nature, based on principles of equity and fairness, and should be liberally construed[.]" *In re Harita*, 6 U.S.P.Q.2d 1930, 1935 (Fed. Cir. 1988) (citing *In re Weiler*, 229 USPQ 673, 675 (Fed. Cir. 1986)).

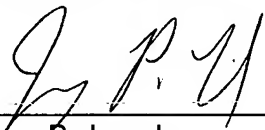
Since this reissue application was prepared and filed to correct an error in the '109 Patent which was made without any deceptive intent (Substitute Reissue Declaration, ¶8), and the error renders the patent partly inoperative, the substitute reissue declaration of Philip Sweeny fulfils the requirements of 35 U.S.C. §251. Accordingly, applicant respectfully requests withdrawal of these rejections.

Claim 14 has been rejected under 35 U.S.C. §112, second paragraph, as indefinite due to the misspelling of the word "halogenated" in the January 10, 2002 Preliminary Amendment. The word "halogenated" in claim 14 of the reexamination certificate is spelled correctly. The misspelling was due to a typographical error in the Preliminary Amendment. Applicant has amended claim 14 to correct this error.

In view of the above remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case be re-issued.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

  
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